

No. 15893

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

~~CEL-REC~~ CHEMICAL Co., INC., a corporation,

Appellant,

vs.

~~DELTO~~ CHEMICALS, INC., a corporation,

Appellee.

APPELLANT'S BRIEF.

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FILED

MAY 26 1958

PAUL P. O'BRIEN, CLERK

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APPELLANT'S BRIEF.

Statement of the Pleadings and Facts.

The District Court had jurisdiction of this case under the Patent Laws of the United States (35 U. S. C., Sec. 281), and this Court has jurisdiction to review the judgment entered in this case. The pleadings conferring such jurisdiction are the Complaint [Tr. p. 3, *et seq.*], the Amended Answer and Counterclaim [Tr. p. 35, *et seq.*], and the Answer to Counterclaim [Tr. pp. 39-40].

This appeal is from a judgment granting appellee's Motion for Summary Judgment and holding that the patent in suit is invalid. The patent in suit, No. 2,653,116, covers a "Method of Removing Sealant from Integral Fuel Tanks" of aircraft. The Lower Court invalidated all the claims of this patent [Tr. p. 153].

This case was originally brought as a declaratory judgment suit, so the plaintiff in the Lower Court is the

accused infringer, and the defendant in the Lower Court is the owner of the patent in suit. The plaintiff-appellee brought the Motion for Summary Judgment in this case at the express invitation of the Lower Court [Tr. pp. 216-218], which invitation was not extended until eight days before the trial was set to begin [Tr. p. 216].

A jury was asked for by the patentee-defendant, but the Lower Court was very reluctant to try this case to a jury, since he has never tried a patent case to a jury and doesn't intend to until he has to [Tr. p. 218].

Specification of Errors.

The points upon which appellant intends to rely on this appeal are as follows:

1.

The Court erred in granting plaintiff's Motion for Summary Judgment.

2.

The Court erred in entering judgment that the patent in suit, No. 2,653,116, is, and each of the claims thereof are, invalid and void.

3.

The Court erred in dismissing defendant's counter-claim.

4.

The Court erred in entering judgment for plaintiff's taxable costs herein.

5.

The Court erred in finding that no genuine issue as to any material fact existed in connection with the determination of plaintiff's Motion for Summary Judgment.

6.

The Court erred in finding that a soapy solution and a water-rinsable, solvent-miscible material are equivalent.

7.

The Court erred in finding that claims 1 to 3, inclusive, of the patent in suit specify a “soapy spray” for a tank before being rinsed, and that “soap” was applied before rinsing.

8.

The Court erred in finding that the prior art which the Commissioner of Patents failed to cite against the application for the patent in suit shows the method of the patent in suit to be old.

9.

The Court erred in finding that in Fig. 5 of Butterworth 2,018,757 the material is passed “through” a weir “or screen.”

10.

The Court erred in not applying said prior art specifically to the claims of the patent in suit.

11.

The Court erred in finding that extrinsic evidence is not needed to explain or evaluate the prior art cited by the plaintiff-appellee in this case, and its applicability to the subject matter of the patent in suit.

12.

The Court erred in finding that the patent in suit (a) does not produce any result not found in the prior art; (b) does not produce any unexpected result; and (c) does not produce any result greater or patentably different than the sum of the various steps or procedures of the prior art.

13.

The Court erred in finding that the patent in suit merely covered an old method of cleaning railroad tank cars, ship tanks, drums, or radiators.

14.

The Court erred in finding that the patent in suit, and each of its claims, lacks invention over the prior art, and is devoid of patentable novelty.

15.

The Court erred in concluding that there was no substantial dispute of fact as to any of the prior art patents.

16.

The Court erred in concluding that questions of anticipation in this case are questions of law.

17.

The Court erred in concluding that questions of want of invention in this case are questions of law.

18.

The Court erred in concluding that questions of validity in this case are questions of law.

19.

The Court erred in not holding that the depositions of Sydney G. Thornbury, Robert C. Bear, Thomas Edgin and C. R. Ursell raise issues of fact as to plaintiff-appellee's Motion for Summary Judgment.

20.

The Court erred in its interpretation of the file wrapper of the patent in suit.

21.

The Court erred in holding that the prior art cited in paragraph 12 of the Findings of Fact is closer than the prior art cited by the Examiner during prosecution

of the application for the present patent through the Patent Office.

22.

The Court erred in not holding that there is a presumption of validity of the patent in suit over said prior art because it is no closer than that cited by said Examiner.

23.

The Court erred in not holding that the prior art fails to show the step in the present patented method of applying a water-rinsable, solvent-miscible material.

24.

The Court erred in deciding, on a Motion for Summary Judgment, a disputed question of fact in connection with the nature, construction and operation of the weir shown and described in Butterworth patent 2,018,757.

25.

The Court erred in holding that the weir of Butterworth patent 2,018,757 is the equivalent of a screen, in the face of the issue of fact raised by defendant-appellant, to wit, that the nature and speed of travel of the solvent-soaked sealant would cause it to pass over a weir but be caught by a screen.

26.

The Court erred in taking "judicial notice of matters of general knowledge" without stating or showing where, or in what way, they were generally known.

27.

The Court erred in holding that "no fact finder could, within the bounds of reasonableness, find validity" in the Letters Patent No. 2,653,116, in suit.

28.

In apparently recognizing that there is "no 'strict anticipation'" of the patent in suit, and that there is "some

novelty” in same, the Court erred in deciding on a Motion for Summary Judgment the disputed question of fact of whether “a trained mechanic” would have solved the present problem “without difficulty” “at the time the invention was made.”

29.

The Court erred in holding that the present patented “cleaning process or method is common to many fields.”

30.

The Court erred in holding that the present patented method was “obvious” to one skilled in the art.

31.

The Court erred in holding that the patented method “is but a mere aggregation of steps long known and employed in the fuel-tank cleaning art.”

32.

The Court erred in not holding that the patent in suit covers an unobvious method that produces a new and useful result over the prior art cited.

Only One Question on Appeal.

This entire appeal appears to hinge upon one question and only one question—is there any material issue of fact involved in this case? If there is none, it would seem that the Lower Court’s decision in granting the Motion for Summary Judgment would not *ipso facto* be reversible error. On the other hand, if there is at least one material issue of fact, then it would appear that it was reversible error for the Lower Court to have granted the Motion for Summary Judgment, and that this case should be reversed and remanded for trial.

Are There Any Questions of Fact?

The effort of this Brief will be largely to point out that there is not merely one disputed question of material fact, but a long series of them, any one of which would appear to prevent determining this action on a Motion for Summary Judgment.

Description of Patented and Prior Processes.

In order to appreciate the disputed issues of fact, a word of explanation of the present process would seem to be in order.

Wings of aircraft are now used for gasoline tanks. However, the gasoline would leak out between the metal-to-metal contact if these wing tanks were not sealed along the seams and around every rivet and bolt. This sealing material is synthetic rubber so as to permit bending of the wings while the aircraft is in flight, without the gasoline leaking out. After awhile, however, this sealing material, called "sealant," becomes hardened and works loose from the metal so as to cause leaks in the gasoline tank. The aircraft industry, by experience, knows about how long this sealant material will last, so, as a safety factor, before the gas tank begins to leak, the sealant is removed and fresh rubbery sealant is applied to all the seams and around all rivets and bolts in the tank.

The first efforts to remove this sealant were by workmen dressed in suits like "Men from Mars," which they wore to protect them from the gasoline fumes and scarcity of oxygen in the tanks. They had to be supplied with oxygen through hoses. In these cumbersome suits, they crawled into the cramped quarters of the wing tanks of aircraft, often only ten or eleven inches high, and, while lying down, laboriously chiseled out the hardened syn-

thetic-rubber-compound sealant, fragment by fragment. This took weeks of time because only one workman could reach a given area at one time, or only one workman could be in the relatively small tank at one time. This was not only expensive for workmen's time, but ground time for the average plane is considered as costing about \$4,000.00 per day.

Because of the difficulties of working under such adverse conditions, and because of the great expense of this method, a new desealing method was sought [Tr. p. 78].

Although patents were in existence at that time covering apparatus for cleaning out tank cars and ship hulls by spray means, it was apparently not obvious to those having ordinary skill in this art that the processes described therein would remove the sealant from aircraft tanks (and, as shown hereinafter, such processes would in fact not remove this sealant).

The next method tried was the "fill-soak-and-drain" method, whereby the aircraft fuel tank was filled to the top with the desealing solvent, permitting the sealant to soak for weeks and then the solvent was drained out with most of the sealant. Then the workmen had to crawl in, dressed in "Men-from-Mars" suits, supplied with air hoses in order to protect them from the highly toxic and often inflammable desealing fumes, and chisel out what always remained after such soaking.

The fill-soak-and-drain method was also time-consuming and very expensive. The fill-soak-and-drain method took 1200 man hours, about two weeks of ground time, and 3,000 gallons of expensive solvent costing about \$3.00 per gallon, for a C-54 or DC-4 plane.

With the industry in this condition, the method of the patent in suit was invented [Tr. p. 80].

The method of the patent in suit is quicker and far less expensive in man hours, gallons of solvent and ground time than the next best fill-soak-and-drain method. Said patented method will desal a C-54 or DC-4 plane with 500 man hours of labor, 600 gallons of solvent and five days' ground time. In other words, the saving in dollars effected by the patented method in an average desalting job on a C-54 or DC-4, as compared with any previous fill-and-soak-and-drain method, is about \$18,700.00, and the total saving to the United States Government by reason of the use of the patented method, over the said previous method, conservatively averages \$2,000,000.00 per year, making a total saving to the Government beginning in 1950, by the use of the patented method, of conservatively over \$12,000,000.00! [Tr. pp. 81-82].

The patented process, which is used by both the appellant and the appellee, finally fills the long-felt need for a less expensive, less hazardous, and quicker method for the removal of this sealant. The apparatus used includes spray means (something like lawn spray means) that are inserted in the tank. The tank is then sealed, and liquid solvent material is sprayed forcibly upon this sealant in the tank for a considerable period of time. The sealant soaks up the solvent gradually, causing the sealant to swell and to become spongy and jelly-like [Tr. pp. 95-96]. This swelling and the force of a relatively high pressure water rinse cause the sealant to loosen from the metal tank and wash the loosened pieces of sealant down the drain-hole in the tank. An entirely new, intermediate step between the solvent spray and the high pressure rinse is dealt with later in this brief.

First Disputed Issue of Fact.

The Lower Court, by taking judicial notice of matters "of general knowledge," held that the present patented method was not new [Tr. p. 139]. Later, the Court said that the present process or method "is common to many fields" [Tr. p. 141].

The several depositions of Brigadier General James L. Jackson, Robert C. Bear, Thomas H. Edgin and Charles R. Ursell, would indicate that it was not common or general knowledge that the sealant could be removed from aircraft fuel tanks by any known methods, other than by laborious "hand-picking" or by the time-consuming and expensive "fill-soak-and-drain" method.

Brigadier General Jackson was one of America's outstanding Air Force officers during World War II. He stated under oath that such information was neither in common nor general knowledge for removing the rather peculiar sealant from aircraft fuel tanks. He specifically stated that there was a pressing need for several years for an improved method of desealing aircraft fuel tanks [Tr. p. 116]. "Many methods were tried and the vendors and mechanics in the trade worked upon the problems and suggested various methods . . . [but] no solution was found until . . . [defendant-appellant] demonstrated the operation of its recirculating spray method during the latter part of 1951." [Tr. pp. 113-115.]

When this method was first called to Brigadier General Jackson's attention, it was neither common nor general knowledge; in fact, he was "skeptical of it" and believed "that the mere spraying of chemicals through small apertures" would not "perform the job effectively" [Tr. p. 115]. He also considered the spraying of the sealant

(which is toxic to human beings) as “more dangerous than previous methods then in use.” [Tr. p. 115.]

Robert C. Bear, foreman of Capital Airlines, Washington, D. C., told of removing sealant from aircraft fuel tanks by the method that was in common use or general knowledge in this industry, to wit, filling the gas tank with the solvent, letting it soak, and then draining out the solvent and loosened sealant: the “fill-and-soak-drain” method. No other method was in common or general knowledge in the industry for removing sealant when the present method was invented by defendant-appellant’s assignors. Bear resisted the new patented method because “everybody was trying to get a new method and a better method, and none of them were any good” [Tr. p. 174]. However, the saving of man-hours—200 vs. 800—, the saving of elapsed time for desealing four DC-4 fuel tanks—55 hours vs. 192 hours—, the saving of expensive material—250 gallons vs. 1200 gallons—, and the safety to employees during desealing [Tr. pp. 175-176], removed the skepticism of this affiant as to the value of this new and different approach to the removal of sealant covered by the patent in suit.

Thomas H. Edgin, mechanical engineer at Tinker U. S. Air Force Base, Oklahoma, was at first “dubious” as to the present patented method of removing sealant, when it was first brought to his attention [Tr. p. 179]. It was in neither common nor general use in the industry. Neither was it obvious, for “numerous trial and error approaches were made” trying to remove sealant satisfactorily, but none of them was effective. Because of the toxic character of the solvent, they were attempting “to find a better method,” but with “very little positive results” [Tr. pp. 179-180]. He made tests comparing the

then generally known and used fill-soak-and-drain method with the patented method and found twenty-one advantages of the latter method over the old, previously known method [Tr. pp. 180-181]. These advantages are listed in detail [Tr. pp. 183-188].

Charles R. Ursell, maintenance engineer for many years for Pan American Airways, Brownsville, Texas, at the time that they were struggling with the old fill-soak-and-drain method, stated that in his opinion a person versed in the art of desealing aircraft integral fuel tanks would not ordinarily think of applying to a desealing operation a method similar to that used in railroad tanks and ships' hulls [Tr. pp. 194-195].

He gave several reasons for this: (1) different types of metal—aircraft are basically aluminum; lightweight and very thin material is used, whereas ships and railroad cars are basically steel and very heavy structure. The loss of any thickness of metal would not mean much in a ship or railroad tank car, but in an airplane "even 1/1000 of an inch is important to us." (2) different size of unit—"a ship or tank is a mammoth thing . . . [or] at least they are normally big enough for a man to get into, whereas an aircraft tank until the B-36 came along [had a] rather small hole in the fuel tank and normally a man couldn't even get into it. (3) At that time normally a hole would not be cut in the wing structure large enough for a man to get through because of the basic structure of the airplane" [Tr. pp. 194-195].

He too was at first skeptical of the new patented process, even though he had known of ships' hulls and railroad tank cars for many years. He said he was "as skeptical as a person can be, because of so many other ideas that were offered along the same line," but after

“viewing the end results” of the patented process, he was “impressed” and “amazed” with the results [Tr. p. 191].

The appellee has relied heavily upon Land patent No. 1,666,015 as showing common or general knowledge of the patented method in the trade. However, by the appellant’s showing, the Land patent was not considered as showing the common knowledge of the patented process, for Turco Products, Inc., the licensee of the Land patent from 1930 to the time it expired in 1945 [Tr. p. 204], took out a license under the patent in suit [Tr. pp. 117, *et seq.*] for a substantial sum (\$20,000 payable over a ten-year period). Turco Products, Inc. is one of the leaders of the chemical industry in the United States [Tr. p. 84]. At first, representatives of Turco Products, Inc. said the patented process “would not work” [Tr. p. 84]. It is submitted that this is evidence that the use of the patented method for the present purpose was not in common knowledge, or it would have been known by one of the largest concerns in this field in the United States, which was also the licensee under the Land patent (relied on by the appellee) and had full knowledge of it!

Although his company had been licensed under the Land patent for a number of years, Sydney G. Thornbury, president of Turco Products, Inc., thought the new patented process would not operate when he first heard of it, and resisted using the new patented method for several reasons [Tr. pp. 199-200].

The affidavit of Edward W. Giddings, vice-president of the defendant-appellant, outlined the method that really was in common and general use in this field when the present patented method came forward, to wit, the old fill-soak-and-drain method [Tr. p. 82]. The spray method was not in common or general use for cleaning aircraft gasoline tanks.

Rather than the patented method being in common or general knowledge, Vice-President Giddings stated that when this new method was proposed, the mechanics engaged in this field said that a mere spray could not remove the sealant because the latter was of a hard, synthetic-rubber-compound. Another objection by such mechanics (who are the ones who would have such "common or general" knowledge) was that the patented method would be more injurious to personnel than the old, then used, fill-soak-and-drain method [Tr. p. 83]. These objections proved incorrect, but they show that the patented method was not in common or general knowledge.

Thus, it appears that the Lower Court, after considering all this evidence, went ahead and decided this issue of fact in favor of appellee on a Motion for Summary Judgment.

As stated in *Hycon Mfg. Co. v. H. Koch & Sons*, 219 F. 2d 353 (C. A. 9), cert. den. 349 U. S. 953, 99 L. Ed. 1278, 75 S. Ct. 881, ". . . Any tendency to abolish trial in patent cases for consideration of documents in camera should be curbed"

Second Disputed Question of Fact.

The second disputed question of fact is an extremely important one and pertains to what is shown in the prior patent upon which the appellee (and the Lower Court) relies most heavily in this case. That is the question of whether the dam or weir 38 of prior Butterworth patent No. 2,018,757 is a screen or is the equivalent of the screen 24 of the patent in suit. This prior patent, it should be noted, is the only one which the Lower Court discusses specifically [Tr. pp. 137-138], so its importance can, therefore, be gleaned.

The appellant's position, as shown by the sworn statement of its patent expert, William Douglas Sellers, is that, "*A weir is not a screen . . . With a screen, foreign particles are removed by not passing through the screen, while the remainder of the material passes through the screen. A weir more nearly approaches a dam . . . A weir requires a settling tank and a relatively large body of quiescent liquid, in order to permit settling*" behind the dam [Tr. pp. 109-110; emphasis added]. The Lower Court decided this disputed point against appellant by stating, "But this is not the teaching of non-cited Butterworth patent No. 2,018,757" [Tr. p. 138]. The Lower Court, it is submitted, fully recognized this dispute as to a matter of fact, and hence should never have proceeded to render judgment on the Motion for Summary Judgment.

Appellant's chemical expert, Keith R. Whitcomb, also adds to this disputed question of fact as to whether the Butterworth dam or weir is the same as, or the equivalent of, the screen in the patent in suit. He stated that the swollen pieces or strips of sealant that are removed from the interior of an aircraft fuel tank as "lightweight, slimy, gooey, jelly-like or sponge-like masses that are substantially the same specific gravity as the solvent, so that such pieces of swollen sealant are substantially held in suspension by the flowing solvent; that is, this spongy, lightweight sealant *neither descends nor rises* in the flowing solvent but is carried along by the solvent" [Tr. pp. 94-95; emphasis added].

The lightweight, non-sinking character of these pieces of sealant material is not the only factor that would render Butterworth's dam or weir inoperative for the present purpose. The material also travels so fast over the dam

or weir that the spongy, jelly-like pieces of sealant cannot settle behind the dam or weir, but are washed over the dam or weir “along with the rapidly moving solvent” [Tr. p. 95].

Here, then, we have the second strongly controverted issue of material fact (controverted by two of appellant’s affiants), to wit, whether Butterworth’s dam or weir will act as a screen in the patented process. The appellant’s position on this question of fact is that because of the non-sinking character of the swollen sealant and because of the rapid flow of the material, the floating sealant will wash right over Butterworth’s dam or weir and clog up the pump and spray in two to four minutes, thus rendering his entire system quickly inoperative [Tr. p. 95]. Due to the fact that there is a serious question as to whether the principal reference relied upon by the Lower Court is operative for the present purpose, here would seem definitely to be a material issue of fact.

It is believed that “it was error to hold that as a matter of law” the devices shown in the patent in suit and in the prior art are dissimilar or similar, where there is conflicting evidence. (See *Moist Cold Refrigerator Co., Inc. v. Lou Johnson Co., Inc.*, 249 F. 2d 246, 255 (C. A. 9, 1957) (reh. den.).)

Third Disputed Issue of Fact.

The Lower Court stated that the prior-art patents not cited by the Patent Office “anticipated” the present patented process [Tr. p. 140]. It is presumed that the Lower Court meant that they anticipated the entire patented process. Obviously, there would not be “anticipation” if only part of the process were anticipated. The Patent Act itself requires that the subject matter “as

a whole” must have been obvious at the time the invention was made (35 U. S. C., Sec. 103). This raises the issue of fact as to whether the prior art patents anticipated the second step of appellant’s patented process. The appellant says they do not, the Lower Court says they do. To see the basis for this issue, claim 2 should be considered, which reads as follows:

“2. The method of removing the sealant from an aircraft integral fuel tank that comprises impinging a spray of volatile solvent against at least the upper portions of the sealant of the tank, simultaneously gravitationally draining free solvent from the tank with removed sealant material, *rendering the solvent water-rinsable by applying a substantially less volatile, water-rinsable, solvent-miscible spray to the solvent on the sealant*, and then applying water under substantially higher pressure than either spray to rinse free liquid of both sprayings, and removed sealant material, from the tank.” (Emphasis added.)

The second step emphasized above is best explained by stating that the patented process covers three steps: (1) spraying volatile solvent material against the sealant in the aircraft fuel tank; (2) applying less volatile, water-rinsable, solvent-miscible spray to the solvent on the sealant, in order to render the solvent rinsable by water; and (3) applying water under higher pressure to wash down the drain the loosened pieces of sealant. Claims 1, 2 and 3 of the patent in suit all cover this *second step* specifically.

The above second step is important for if the second step were omitted and water were applied after the first step, the solvent would merely be washed away and the sealant would “re-set” [Tr. p. 96]. The material used in this second step will both mix with the solvent (*i.e.*, is

“solvent-miscible”) and can be rinsed with water (*i.e.*, is “water-rinsable”). Water alone cannot accomplish both of these results.

An issue of fact arises over whether the soap solution of the prior patent to Foster 1,141,243 anticipates this step. Foster was cited by the Examiner during the prosecution of the patent in suit through the Patent Office; no other patent cited by the appellee or the Lower Court appears to show even a soapy solution for washing out a tank.

However, soap or a soapy solution is not solvent-miscible, and would not prevent the sealant from returning to a hardened material and to a water-insoluble material. In fact, soap or a soapy solution would wash away the solvent and cause the sealant to re-set as a hardened rubber compound. Thus, soap or a soapy solution would be inoperative and produce just the opposite results from those desired [Tr. pp. 96-97]. The salt water and caustic soda of Butterworth 2,018,757 is also not solvent-miscible, and instead of removing sealant that is saturated with solvent, such “cleansing liquid” would wash out the solvent and tend to re-set the sealant against the wall of the fuel tank in hardened masses [Tr. p. 97].

The Lower Court found in Finding of Fact 11 [Tr. p. 148] that claim 1 of the patent in suit “specifies that the tank is given a *soapy* spray before being rinsed” (emphasis added). This, it is submitted, is clearly contrary to the affidavit of the appellant’s chemical expert, as stated in the next preceding paragraph herein, and is definitely a decision by the Lower Court on a hotly disputed issue of fact. This determination alone appears sufficient basis for reversing the Lower Court in this case.

It is not denied by either the appellee or the Lower Court that this second step in the patented process is an important one, which it certainly is for the reasons stated. Whether this second step accompanies or precedes the third washing step, the prior art should show this second step or there is no "anticipation."

The Lower Court held in Conclusion of Law 3 [Tr. pp. 152-153] that extrinsic evidence was not required to explain the prior art. The Court is believed clearly erroneous in this, for an explanation is necessary to understand that the prior art does not show anything that would take the place of the present patented second step. The fact that the Lower Court apparently never understood this lack of anticipation is ample evidence that extrinsic evidence was necessary for explanation.

The affidavit of the appellant's patent expert, William Douglas Sellers, states as a fact that none of the prior patents relied on by appellee herein teaches the use of a "less volatile" emulsifier that is "solvent-miscible" between the use of a volatile solvent and just water [Tr. p. 107]. None of the prior art in this case has or suggests appellant's patented "three-step method" [Tr. p. 107].

This second step produces the result of rendering the solvent miscible with water. As shown, this is not found in any of the prior art. However, the Lower Court, again, decided a disputed issue of fact by finding in Finding of Fact 21 [Tr. pp. 151-152] that the present patented method did not produce any result not produced in the prior art. Of course, the Lower Court should not have decided this issue of fact on a Motion for Summary Judgment, in the face of a *contra* affidavit by a patent lawyer.

The affidavit of a patent lawyer that brochures did not contain any disclosure of the details shown and claimed in the claims of the patent in suit raised "an issue of fact which must be determined."

Panaview Door & Window Co. v. Van Ness, 135 Fed. Supp. 253 (D. C. S. D. Cal., 1955, Jertberg, J.).

Thus, it is submitted that, whether this second step is anticipated by the prior art is an issue of fact submitted to the Lower Court as being one squarely opposed by the parties. On a Motion for Summary Judgment, it does not seem that the Lower Court should have decided this question of fact.

It is believed that the Lower Court was in error in not applying the prior art specifically to the claims of the patent in suit (10th Specification of Error, *supra*).

The Court in its Decision stated:

"It would serve no useful purpose to labor here the detail of a comparison of the essential steps embraced by the cleaning methods disclosed in the prior-art patents involved here, both cited and uncited."
[Tr. p. 139.]

If the Court had specifically made a point-by-point application of the prior art to the claims in suit, it is believed that it would have been more conscious of the omission by all the prior art, cited and uncited, of this second step.

Because of this very important second step, and because it is quite technical as to why the water or steam of the prior art would be detrimental and would not perform the same purpose, it is believed that the Lower Court was in error in holding that "extrinsic evidence"

was not needed for the purpose of explanation of the prior art [Tr. p. 137]. This is the 11th Specification of Error, *supra*.

Fourth Disputed Issue of Fact.

The Lower Court also made a decision as to a fourth disputed issue of fact, to wit, that the method of the patent in suit is “but a mere aggregation of *steps long known* and employed in the fuel-tank cleaning art.” [Tr. p. 142; emphasis added.]

It is one of appellant’s strongest arguments that the second step, considered more thoroughly hereinbefore, was never before known in the fuel tank—, or any other tank—cleaning art. The sealant is a different material than heretofore encountered in cleaning out a tank. It is a synthetic-rubber-compound that has hardened in place and it takes a week or two of constant soaking to loosen it [Tr. p. 83]. It is not like milk, molasses, or other material that can be removed by hot water or steam. Water or steam would be objectionable in removing aircraft tank sealant, for they would merely wash away solvent and re-set the rubber sealant.

Thus, the second step of the patented process is believed to be entirely new in the removal of sealant (or any other material) from a tank. What is even more important, the prior art relied upon by the appellee and by the Lower Court does not in any way, shape or form anticipate or even suggest the said second step!

Thus, the Lower Court is believed to have decided this case on what it believes to be the merits of the case, rather than recognizing that there is a sharp issue of fact as to whether the second step of the patented process is suggested by a single one of the prior art references.

The affidavit of a patent lawyer that brochures did not contain any disclosure of the details shown and claimed in the claims of the patent in suit raised “an issue of fact which must be determined.”

Panaview Door & Window Co. v. Van Ness, 135 Fed. Supp. 253 (D. C. S. D. Cal., 1955, Jertberg, J.).

Thus, it is submitted that, whether this second step is anticipated by the prior art is an issue of fact submitted to the Lower Court as being one squarely opposed by the parties. On a Motion for Summary Judgment, it does not seem that the Lower Court should have decided this question of fact.

It is believed that the Lower Court was in error in not applying the prior art specifically to the claims of the patent in suit (10th Specification of Error, *supra*).

The Court in its Decision stated:

“It would serve no useful purpose to labor here the detail of a comparison of the essential steps embraced by the cleaning methods disclosed in the prior-art patents involved here, both cited and uncited.” [Tr. p. 139.]

If the Court had specifically made a point-by-point application of the prior art to the claims in suit, it is believed that it would have been more conscious of the omission by all the prior art, cited and uncited, of this second step.

Because of this very important second step, and because it is quite technical as to why the water or steam of the prior art would be detrimental and would not perform the same purpose, it is believed that the Lower Court was in error in holding that “extrinsic evidence”

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It is one of appellant’s strongest arguments that the second step, considered more thoroughly hereinbefore, was never before known in the fuel tank—, or any other tank—cleaning art. The sealant is a different material than heretofore encountered in cleaning out a tank. It is a synthetic-rubber-compound that has hardened in place and it takes a week or two of constant soaking to loosen it [Tr. p. 83]. It is not like milk, molasses, or other material that can be removed by hot water or steam. Water or steam would be objectionable in removing aircraft tank sealant, for they would merely wash away solvent and re-set the rubber sealant.

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Thus, the Lower Court is believed to have decided this case on what it believes to be the merits of the case, rather than recognizing that there is a sharp issue of fact as to whether the second step of the patented process is suggested by a single one of the prior art references.

Fifth Disputed Issue of Fact.

Fifth, the Lower Court held that “the patents not cited by the Examiner are decidedly more pertinent to the precise art of the claimed invention than those which were cited” [Tr. p. 139]. Here, the Court was again actually *deciding* a disputed question of fact. Appellant’s patent expert, William Douglas Sellers, has averred under oath that the patents not cited by the Examiner and relied upon by the appellee herein “are no more relevant or persuasive of non-invention” in the patent in suit, than the “patents cited by the Examiner” [Tr. p. 100]. An example of this is the fact that the “soapy-spray” Foster patent, cited by the Examiner, is the only prior patent relied on which introduces anything other than water, steam or caustic soda, to clean a receptacle. If anything, this Foster patent is closer than any of the non-cited art relied upon by the appellee.

The appellee, of course, takes a contrary view on this question of fact (or its entire case upon which the Lower Court granted the Motion for Summary Judgment collapses). *The Lower Court’s decision depends entirely upon its decision on this question of fact.* If the appellant’s expert is correct that the references relied upon by the appellee are no closer than those cited by the Examiner, then the patent in suit would be presumed to be valid over the prior patented art, and the Motion for Summary Judgment would fail.

It is believed that the Lower Court was clearly erroneous in asserting a half-truth in Conclusion of Law 2 [Tr. p. 152] to the effect that there is no presumption of validity as to prior art not cited by the Patent Office. It is felt that the Lower Court should have said that

there is no presumption of validity as to prior art that is *closer to the patent in suit* than the prior art cited by the Patent Office.

This, then, is believed to be the fifth disputed question of fact which should not have been (but which was) decided by the Lower Court on a Motion for Summary Judgment.

Sixth Disputed Issue of Fact.

The Lower Court also held in its decision that the whole of the present patented method does not exceed “the sum of its parts” [Tr. p. 142]. Here again, the Lower Court is overlooking evidence that the method does exceed the sum of its parts, as follows:

Prior to the advent of the present patented process, the “stringers” of airplanes could not be cleaned except by removing same. Stringers are the long, narrow, hollow, strengthening members that extend throughout the length of the airplane wings [Tr. p. 92].

It was thought that it was impossible to clean these stringers. The Wyandotte Chemical Co., a large chemical concern, made a study of this problem, at a cost of \$150,000, for the United States Air Force, and their conclusion was that it was impossible to clean the stringers unless the wings of the aircraft were rebuilt [Tr. p. 93]. Then, along came the present patented process which successfully cleaned the stringers for the first time without rebuilding the wings. So, now, the United States Air Force requires the stringers to be cleaned when desealing an aircraft fuel tank. Thus, the standards for desealing jobs done for the United States Government have been materially raised by this unexpected result of

the patented method. This is believed to be evidence that a result is obtained that is greater than the sum of its parts.

Another result was that the fine vapors or fumes from the spray of the patented process produced an unexpected dividend! Contrary to what was expected, it was possible to reach areas effectively with the fumes where the solvent in liquid form would not go [Tr. p. 204].

Still another unexpected advantage of the patented method was that there is heat generated by impingement of the spray upon the sealant, which heat causes volatilization of the solvent at the very point where needed [Tr. p. 92].

These several unexpected results are all evidence that the sum total of the steps of the patented method is greater than its parts. At least, it is believed that the Lower Court should not have made a decision on this point on a Motion for Summary Judgment, when there is evidence to the contrary. The question, "Does the whole exceed the sum of its parts?" is definitely a question of fact.

It is believed that the Lower Court was too anxious to decide the present case. As the Lower Court said in another case, "I am ready to entertain a motion for summary judgment on the issue of validity in any patent case" [Tr. p. 128].

Implied Concessions by Lower Court.

There are hints in the Decision that the Lower Court itself is not too convinced that all the steps of the present patented method are old and of "general knowledge" [Tr. p. 139], or that the method is "common to many

fields” [Tr. p. 141]. In fact, elsewhere in the Decision, there is not one, but four hints that all is not well with these somewhat inconsistent statements of the Lower Court.

First, the Lower Court stated that, “Even if it be said that there appears no ‘strict anticipation’ of the patent in suit, and that the method involves some novelty . . .” The Court then cites an authority that, “although there is no strict anticipation and even though the . . . [methods] involved may not be similar . . .” [Tr. p. 140].

The second suggestion of doubt as to whether every one of the steps of the patented process is of “general knowledge” or “common to many fields,” comes in the Court’s next citation, to the effect that no invention is ordinarily involved “even though changes and modifications are essential to the practical application of the method . . . to the new use” [Tr. p. 141].

The third hint comes on page 144 of the Transcript of Record, in the Court’s statement that the patent in suit is invalid for strict anticipation, “or, in any event, for want of patentable novelty.”

Lastly, the Lower Court concludes, “So in the case at bar, even if the disclosures of the non-cited-prior-art patents be said to fall short of complete anticipation . . .” [Tr. p. 144].

The Decision, therefore, appears somewhat indefinite as to whether the Lower Court’s position is that the patented method is old because of general knowledge and because it is common to many fields, or that even though the patented method is different than used in any other field, nevertheless no one “within the bounds of reasonableness, could find validity here” [Tr. p. 140].

Seventh Question of Fact or Mixed Question of Law and Fact.

The Lower Court had presented to it here the question of whether the admitted improvement which the patented method made over the prior art (the new second step) was mere mechanical skill or required the exercise of the faculty of invention. It is submitted that this was a question of fact and should have been left for the determination of the jury, and not decided by the Lower Court. See the following quotation from *Thomson v. Ford Motor Co.*, 265 U. S. 445, 446, given by Pope, J., in his concurring opinion in *Bergman v. Aluminum Lock Shingle Corp.*, 251 F. 2d 801, 116 U. S. P. Q. 32, 39 (C. A. 9, 1957):

“The question whether an improvement requires mere mechanical skill or the exercise of the faculty of invention, is one of fact; and in an action at law for infringement is to be left to the determination of the jury.’ ”

In accordance with the case of *Hansen v. Safeway Stores, Inc.*, 238 F. 2d 336, 339 (C. A. 9, 1956), it is believed that the appellant here should not be deprived of its constitutional rights under Article VI of the Constitution to a trial by jury, for the questions of novelty and invention are questions of fact and should be tried by a jury.

“And invention is a question of fact, in ordinary circumstances such as are found here.”

Hutchens v. Faas, 249 F. 2d 465 (C. A. 9, 1957).

The circumstances in the instant case are ordinary to say the least.

The question of validity of a patent claim is one of fact.

Stauffer v. Slenderella Systems of Cal., Inc., 115 U. S. P. Q. 347 (C. A. 9, 1957), citing a long list of Ninth Circuit cases to the same effect.

“In summary, this court has consistently held that the question of validity of a claim of a patent is one of fact.”

Container Corp. of America v. M.C.S. Corp., 250 F. 2d 707 (C. A. 9, 1957).

“ . . . the question of novelty and invention is one of fact as to which the conventional clearly erroneous test is applicable.”

Oriental Foods, Inc. v. Chun King Sales, Inc., 244 F. 2d 909 (C. A. 9, 1957).

At the most, the question of invention is a mixed question of law and fact. See the earlier case of *Hycon Mfg. Co. v. H. Koch & Sons*, 219 F. 2d 353 (C. A. 9, 1955), cert. den. 349 U. S. 953, 99 L. Ed. 1278, 75 S. Ct. 881:

“ . . . But the utmost which can be said in a patent validity case is that it is a ‘mixed question of law and fact.’ ”

Whether the changes made by appellant’s assignors over the prior art constituted mere mechanical skill or required invention, therefore, should not have been decided on a Motion for Summary Judgment because of the opposing contentions of the appellant and appellee. As stated in the *Hycon* case, *supra*, “Both contentions of fact could not be true.”

The Lower Court held that even though the present process may be novel, nevertheless it would have been

foreseen by a mechanic trained in the art [Tr. pp. 140-141]. Nothing could be more clearly a decision on a question of fact than this. The bulk of appellant's evidence was submitted for the purpose of showing that the patent was not, as a matter of fact, and could not have been, foreseen by a mechanic trained in the art. The appellant presented evidence as stated to show that three trained mechanics and one General of the United States Air Force in charge of maintenance and repairs of aircraft, did not conceive of the patented process, and were in fact surprised when it operated successfully. The Lower Court chose to believe contrary to this evidence, which is a clear-cut, fact-finding process.

The Lower Court states that where a method is common to many fields, its application to a new field "ordinarily" involves no more than mechanical skill [Tr. p. 141]. But the question here is whether or not in this case and under these circumstances—not ordinarily—no more than mechanical skill was involved, and it is thought that question cannot be answered except by an evaluation of evidence presented at a plenary trial.

In citing *Dow Chemical Co. v. Halliburton Oil Well Cementing Co.*, 324 U. S. 320, the Lower Court indicates that the present patent monopoly should not be sustained because it contributes so "insubstantially" to the fund of public knowledge [Tr. p. 142]. Here, the Court is deciding what is substantial and what is not substantial. This is a clear evaluation of facts, not thought to be permitted on a Motion for Summary Judgment.

Eighth Disputed Issue of Fact.

The Trial Court's Finding of Fact 8 [Tr. p. 147] states as a fact that the subject matter of the patent in suit was treated and considered by both the Commissioner of Patents and the applicants (appellant's assignors) as being within and analogous to the general art of tank cleaning. Apparently it is the position of the Lower Court that this was an admission of fact against interest made by applicants for the patent in suit.

Here, however, is another disputed issue of fact. The appellant contends, and the affidavit of the patent expert William Douglas Sellers is, *contra* to this holding of the Lower Court. The said patent expert stated [Tr. p. 110]:

“Patents in that field were cited by the Examiner and it was at *all* times contended by the attorney of record that they did not anticipate the claims now in the patent in suit . . .” (Emphasis added.)

Instead of the record showing that the Commissioner in the end held that the patent in suit was in the general art of tank cleaning, on the contrary, after the argument was made by the patentees' attorney,

“ . . . the Examiner impliedly admitted the soundness of such argument by allowing the patent in suit despite such prior patented cleaning apparatus.” [Tr. pp. 110-111.]

This, then, is another disputed issue of fact: does the file wrapper comprise an admission by the Examiner that the ordinary tank cleaning art does not anticipate, or is it an estoppel by the patentees that it does apply?

An Over-all Disputed Issue of Fact.

It is believed clear from the foregoing that it is a material issue of fact of over-all importance as to whether or not the patented process "as a whole" was "obvious at the time the invention was made, to a person having ordinary skill in the art." (35 U. S. C., Sec. 103.)

Evidence that it was not obvious runs throughout the record. There is also specific evidence in the record that the present patented method was not obvious because in a sense the present method is "exactly opposite" to the tank cleaning processes of the prior art [Tr. p. 79].

The affiant Edward W. Giddings, Vice-President of the appellant, avers that tank cars or ship hull cleaning is different than removing sealant from aircraft fuel tanks. Oil, asphalt or scale are not intended to be and are not normally part of a tank or ship, and they are removed as foreign substances as soon as possible [Tr. p. 79]. On the other hand, sealant is a normal, permanent part that is built right into the aircraft, and removing it is a step in repairing it, for new sealant is replaced in the fuel tank as soon as the old sealant is removed [Tr. p. 79]. "An aircraft cannot be flown without the sealant," he states. "It is an integral part of the aircraft. The oily or asphalt residue or scale are detriments to the tank car or ship and should be removed, the sooner the better." [Tr. p. 79.]

The patent expert Sellers puts it another way. He likens washing milk or oil from a tank, to washing dirt from the side of a stucco house with a hose. He avers that in his opinion such a washing process is distinct from the unique discovery that such technique is suitable for removing permanent stucco, which would appear not removable by a hose [Tr. pp. 108-109].

Lower Court Disregards Issues of Fact.

The Lower Court disregarded a number of issues of fact presented to it.

The affidavit of George H. Boeck [Tr. pp. 73-75] states that of his personal knowledge Exhibits K, L and M were reproduced in quantity and given by him and other Oakite representatives to "many customers and prospective customers." The *contra* affidavit of Vesta M. Nelson [Tr. pp. 121-124] shows that in a subsequent conversation, the said George H. Boeck admitted that he had no personal knowledge of the quantities that were produced or what distribution, if any, was made by the other representatives of Oakite.

A sharp issue of fact arises as to whether there was a general or limited distribution of Appellee's Exhibits G, H, K, L and M. Obviously, if there were no general circulation, they can hardly be said to be publications. The only ones to whom George H. Boeck gave copies were those customers or prospective customers to whom he fully explained the whole construction. The few copies that were purportedly given out by Mr. Boeck did not constitute a "general" circulation thereof. Mr. Boeck, himself, gave out only six copies of Exhibit M down to 1953. Since 1945 is the earliest date or copyright date on said exhibits, it would appear that in the eleven years from 1945 to 1956, Mr. Boeck gave out Exhibits G, H, K and L on an average of a little less than one per year to an average of less than one and one-half per year as the top figure. He gave out Exhibits G and H only when they were attached to Exhibits K and L. It is submitted that a genuine issue of material fact is raised as to whether Mr. Boeck did in fact circulate these exhibits to

“many customers and prospective customers” or whether they were shown only to a few customers and prospective customers in a very limited, restricted way. Sending copies of photographs to dealers for the purpose of enabling them to give orders is not a publication. (See *Falk v. Gast Lithographing and Engraving Co.*, 54 Fed. 890, 893 (C. A. 2).) At the very most, the only purpose of Mr. Boeck showing the drawings and written description to his customers was to enable them to make purchases of equipment therefor from Oakite Products, Inc.

This conflict of testimony raises a question as to the credibility of Boeck’s entire affidavit, relied upon by the appellee. The credibility of an affiant raises a genuine issue of material fact. See the Supreme Court case of *Sartor v. Arkansas Natural Gas Corp.*, 321 U. S. 620, 88 L. Ed. 967, 973, 64 S. Ct. 724 (1944), which is quoted or cited several times in Ninth Circuit cases in decisions on motions for summary judgment, and is a leading case on the subject.

A genuine issue of credibility should not be resolved on a Motion for Summary Judgment. See *Moore’s Federal Practice*, 2d Ed., Vol. 6, p. 2139:

“The general and well settled rule is that the court should not resolve a genuine issue of credibility at the hearing on the motion for summary judgment, whether the case be a jury or court case; and if such an issue is present the motion should be denied and the issue resolved at trial by the appropriate trier of the facts, where, to the extent that witnesses are available, he will have the opportunity to observe their demeanor.”

Issue of Fact as to Exhibit H.

The appellee asked in its Counter-Designation that Exhibit H, Directions of Oakite Products, Inc., be printed *in extenso* in the Transcript of Record. The fact that it is approximately twenty-two pages long and is the longest single item in the entire record, may give some idea of the prominence which appellee attaches to it. Exhibits F, I, K, L and M relate to the Oakite matter also. It is believed that issues of fact based on these six different exhibits should not be disregarded.

Exhibit H states that it uses "a cylindrical strainer" that is "fine mesh" and with "an area of not less than 3 sq. ft. of 10 mesh wire." This fine mesh strainer is in every suction line that leads "from each tank to the intake opening of the pump" [Tr. pp. 56-57].

The appellant's chemical expert Whitcomb avers that this Oakite construction "would not screen out 'sealant from the solvent' as specifically covered in most of the claims of the patent in suit" and that the Oakite apparatus "would be clogged by the swollen, spongy sealant in about two minutes" if used to try to remove such sealant in the patented process [Tr. pp. 95-96].

Here we seem to have another strongly controverted issue of fact that should not have been avoided by the Lower Court.

Lower Court Cannot Merely Decide What It Considers "Dispositive."

The Lower Court sidestepped all the foregoing issues with regard to Boeck's affidavit and the operability of the Oakite reference by merely saying that it only needed to adjudicate "a single issue which is dispositive of the

case” [Tr. pp. 144-145], citing Fourth and Seventh Circuit cases and a decision of the Lower Court itself along the same line in another case, which was not appealed to this Court. However, it is believed that this Circuit has a different rule:

“On summary judgment an issue of fact cannot be disregarded because the trial judge believed some other issue was decisive. Such a course would lead to multiple appeals of the case.”

Gillespie v. Norris, 231 F. 2d 881, 883-884 (C. A. 9, 1956).

Thus, it appears that because of this alone, the Lower Court’s Decision should be reversed and remanded for a trial of disputed issues, including both that which the Court considers dispositive and the other issues of fact as well.

Court’s Reaction.

Because of the Lower Court’s crowded calendar, appellant has every sympathy with such Court trying to short-circuit a jury trial, but it is believed that the Lower Court erred in “short cutting” this case. This Honorable Court in *Hycon Mfg. Co. v. H. Koch & Sons*, 219 F. 2d 353, 355 (C. A. 9, 1955), cert. den. 349 U. S. 953, 99 L. Ed. 1278, 75 S. Ct. 881, cautioned lower courts in this Circuit against granting motions for summary judgment when there is a dispute about a fact:

“. . . It is realized that the learned trial judge took this action under the pressure of a heavy calendar and in order to save time for the parties and attorneys. As often happens, the shortcut did not accomplish the desired end. . . .”

The Lower Court had a different view, as to granting a jury trial, in another case. It stated, in said other case, "I am favorably disposed to grant a jury trial to anyone who wants a trial by jury, even in a patent case." [Tr. p. 126.]

Furthermore, the Lower Court said in said other case:

" . . . I agree wholeheartedly with the remarks of Judge Learned Hand with respect to the elusiveness of the non-existent standard for the determination of what is invention.

"Now, I daresay that most juries know just about as much about it as most judges." [Tr. p. 126.]

Also:

" . . . And with all due deference, as far as I am concerned, I think 13 people sitting over there in the box know just about as much about it as I do." [Tr. pp. 127-128.]

Lower Court Relies on Abandoned Position of Patent Office Examiner.

The Lower Court refers to the earlier, tentative holding of the Examiner in the Patent Office that at that time (December 2, 1952) the Examiner's opinion was that " . . . separation by settling is considered the full patentable equivalent of . . . [applicants'] screens" [Tr. p. 138].

The Lower Court took this statement to be the ultimate decision of the Examiner. It should have been noted, however, that the Examiner reversed this first ruling after considering the affidavit of the chemical expert Keith R. Whitcomb, dated July 7, 1953 and filed with the amendment of July 15, 1953. This affidavit distinctly

pointed out that the Butterworth patent cited by the Examiner would not operate for the present purpose since settling would not remove the swollen sealant from the solvent because the swollen sealant would be,

“ . . . held in suspension, since it has approximately the same specific gravity as the cleaning fluid; thus the swollen solvent neither rises nor settles. Moreover, the circulation of the fluid in applicants' process is so rapid, as to absolutely prevent settling . . . but the cleaner or solvent circulates at the rate of 150 gallons per minute, so that settling is absolutely prevented.” [See file wrapper, filed herein as a physical exhibit.]

In due course, the Examiner, after considering the foregoing affidavit, giving the reasons why a settling tank was not the patentable equivalent of the applicants' screens, reversed himself and allowed the claims of the patent in suit.

This is believed to be a full answer to the Lower Court's exclamation, “One reads the file wrapper and wonders upon what possible ground the letters in suit issued, even over the prior art cited.” [Tr. p. 140.]

Thus, the Lower Court bases its decision on an earlier, abandoned position of the Examiner, in deciding this disputed question of fact (as to the possible equivalence of screens and weirs).

Patent in Suit Carefully Considered by Patent Office.

The Lower Court commented (apparently in derogation of the patent in suit) that the application for the patent in suit was “at length” allowed after amendment of the original claims, after personal interviews with the Examiner, and after associate counsel appeared [Tr.

p. 131]. Instead of detracting from the value of the patent in suit, it is believed that all this shows that the patent in suit was not carelessly or haphazardly granted, but that it was issued only after full and careful examination of the application by the Examiner in the Patent Office. It would appear that the Lower Court should have been more reluctant, not less reluctant, to strike down a patent in a summary proceeding that had been given such serious and prolonged study by the experts in the Patent Office.

The presumption of validity is strengthened when there were extensive administrative proceedings concerned with prior art.

Otto v. Koppers Co., Inc., 246 F. 2d 789 (C. A. 4, 1957).

Lower Court Holds Evidence “Undisputed.”

In its quotation from *Mettler v. Peabody Eng. Corp.*, 77 F. 2d 56 (C. A. 9), [Tr. p. 140], the Lower Court recognizes that there must be clear, “undisputed” evidence of anticipation by the prior art not cited by the Patent Office, to overcome the presumption of validity of an issued patent. Certainly the appellant, while defendant in the Lower Court, forcefully disputed the question of anticipation by the non-cited prior art—see the foregoing arguments with regard to: (1) the present process not being in common use or in general knowledge; (2) the novel second step of the patented process; (3) the “weir” of Butterworth patent 2,018,757; (4) the “soapy” solution; and (5) the operativeness of the Oakite construction.

These points were anything but “undisputed,” and the Lower Court had to make a decision as to each of these

disputed questions of fact before it could hold that the patented process was anticipated. These issues, it is submitted, should have been decided only after a plenary trial.

Lower Court Applies Wrong Criteria.

The Lower Court stated that no fact finder could “within the bounds of reasonableness” find validity here [Tr. p. 140], and decided to render a decision in this case on a Motion for Summary Judgment if it could understand the patent in suit and the prior art [Tr. p. 217 and see “easily understood,” Tr. p. 136]. It is submitted that on a Motion for Summary Judgment the questions of “reasonableness,” or whether the patent in suit and the prior art could be understood by the Court, are not the proper criteria. The only question before the Court in such summary proceeding is, “Does there exist a dispute as to any material question of fact?”

Conclusion.

It is submitted that the Lower Court, in taking a short cut in this case, has decided numerous, disputed, material questions of fact on a Motion for Summary Judgment. This is thought to be clearly erroneous. For the many reasons given hereinbefore, it is believed that the Judgment should be reversed and remanded, in order to have a plenary trial upon the many controverted issues of fact.

Respectfully submitted,

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